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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/721,479	11/22/2000	Doris Coit	PP01617.002	2173

7590 06/15/2004

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EXAMINER

CHEN, STACY BROWN

ART UNIT	PAPER NUMBER
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1648

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/721,479

Applicant(s)

COIT ET AL.

Examiner

Stacy B Chen

Art Unit

1648

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 April 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 22 April 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.  
2. ☐ The proposed amendment(s) will not be entered because:  
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ they raise the issue of new matter (see Note below);  
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.  
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.  
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 1,4-19,32 and 43-50.

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☒ The drawing correction filed on 21 April 2004 is a) ☒ approved or b) ☐ disapproved by the Examiner.  
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.  
10. ☐ Other: \_\_\_\_\_

Continuation of 5. does NOT place the application in condition for allowance because: Claims 1, 4-19, 32 and 43-50 remain rejected under 35 U.S.C. 112, first paragraph for failing to comply with the written description requirement. Written support for a mutant NS3 polypeptide having a deletion of "the amino acid sequence corresponding to amino acids 1027-1241 of HCV-1" is not in the disclosure. Applicant's arguments have been carefully considered but fail to persuade. Applicant points to the specification on pages 11 and 58, which disclose a mutant NS3-5 polypeptide having amino acids 1242-3011. Applicant reasons that since the full-length sequence of NS3 is known to be amino acids 1027-1657, and an NS3-5 mutant is described that lacks NS3 amino acids 1027-1241, that one would arrive at the claimed invention: a mutant NS3 polypeptide having amino acids 1027-1241 deleted. The specification only supports an NS3-5 polypeptide having a portion of NS3 (amino acids 1242-1657) and NS4 and NS55. There is no support in the specification for making a mutant NS3 polypeptide comprising amino acids 1242-1657. Therefore, the claims remain rejected for failing to meet the written description requirement.

Applicant expressed concern regarding comments made in the last Office Action dated October 21, 2003 regarding the reinstatement of the obviousness rejection over new claims 43-50. Applicant asserted that a rejection cannot be reinstated on new claims that have not been rejected. For clarification, new claims 43-50 were presented along with the amendment specifying "amino acids 1027-1241". Were it not for the amendment, the new claims would have been subject to the same art rejection as claims 1, 4-19 and 32, and the art rejection would have been reinstated for claims 1, 4-19 and 32. The examiner intended to assist Applicant by informing Applicant that if the new matter was removed (or the rejection was overcome), the art rejection that had been applied to claims 1, 4-19 and 32 would be applicable to the new claims. New claims presented in an amendment after a first office action are subject to being finally rejected.

*SBC*  
Stacy B. Chen  
Art Unit 1648  
June 3, 2004

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